

## **REMARKS**

Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

### **Status of the Claims**

Claims 1-23 are pending. Claims 1 and 9 have been amended. No new matter has been added.

Claims 1-23 stand objected to for containing the informal abbreviation "AV." Applicants have amended claim 1 to recite the parenthetical phrase "audio, video, or audio video" after the first occurrence of "AV." No new matter has been added, nor has there been a narrowing of the subject matter recited within claims 1-23. Withdrawal of the rejection is requested.

### **Rejection Under 35 U.S.C. § 112**

Claim 9 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Claim 9 has been amended, and Applicants submit that claim 9 is in conformance with the requirements of 35 U.S.C. § 112. Therefore, Applicants request withdrawal and reconsideration of the rejection.

### **Rejection Under 35 U.S.C. § 102**

Claims 1, 11, 12 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,739,864 to Copeland. Applicants respectfully traverse the rejection.

The Examiner contends that Copeland discloses all the features recited in claims 1, 11, 12 and 22. The Examiner contends the Copeland discloses a digital watermark generating means as a Data Modulator of Figure 1, a digital watermark data 20 indicating an identification

of the reproduction equipment, a digital watermark embedding means represented by the video processor 14 in Figure 1, which embeds or adds the digital watermark to an input video signal 12.

Applicants submit that Copeland discloses a device that combines data with the video input signal. Copeland, claim 1 recites “said blanked data is combined with said video input signal.” (Copeland, column 7, lines 43-44.) The data in Copeland which is combined relates to the SYNC word and the Horizontal and Vertical blanking signals. Additionally, the data itself is modulated. The term “combined” is not defined nor explained in Copeland’s disclosure. Merriam-Webster Online Dictionary defines the verb “combine” to mean “to bring into such close relationship as to obscure individual characters.”

In contrast, the claimed invention relates techniques operable to embed attribute information in the form of a digital watermark. Where the attribute information specifies the reproduction device into audio video signals. Applicants submit that the present claims are remarkably different from the disclosure of Copeland,. Additionally, Copeland’s limited disclosure would not enable a person of ordinary skill in the art at the time of the present invention to achieve the invention of claims 1, 11, 12 and 22. Withdrawal and reconsideration of the rejection is requested.

Claims 10, 21 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,246,802 to Fujihara et al. (“the ‘802 Patent”). Applicants respectfully traverse the rejection.

Applicants note that 35 U.S.C. § 102(b) provides that:

A person shall be entitled to a patent unless —

...

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The '802 Patent issued on June 12, 2001. The present application was filed with the U.S. Patent and Trademark Office on August 29, 2001. Thus, the '802 Patent was patented in this country less than three months prior to the date of application for patent of the present invention. Therefore, the '802 Patent itself does not qualify as prior art under 35 U.S.C. § 102(b).

Withdrawal and reconsideration is requested.

Applicants note that the '802 Patent claims foreign priority to three Japanese Patent documents (JP 8-259771, JP 8-259772, and JP 9-050195). Applicants are unable to determine if JP 8-259771 and JP 8-259772 ever published. Applicants have determined that JP 9-050195 published in the Japanese language on September 6, 1998. Applicants have not obtained a translation of this document, and have made no determination as to whether it independently matches the disclosure of the '802 Patent.

**Rejection Under 35 U.S.C. § 103(a)**

Claims 2-9 and 13-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copeland in view of the '802 Patent. Applicants respectfully traverse the rejection.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the


references, i.e., there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (Emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure.” *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

Applicants submit that there is no suggestion in Copeland or the ‘802 Patent to combine these references. Instead, the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee’s claimed invention from prior art by using the patentee’s claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q.2d at 1532, citing *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

### **CONCLUSION**

Each and every point raised in the Office Action dated October 4, 2004 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-23 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

Respectfully submitted,

  
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